Doc Code: AP.PRE.REQ

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) YOR920040028US1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature_____ Typed or printed name _____	Application Number 10/785,227	Filed February 25, 2004
	First Named Inventor Samuel S. Adams et al.	
	Art Unit 2143	Examiner Belani, K.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
      Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number ____36,769____.

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

_____
Signature

Frederick E. Cooperrider
Typed or printed name

____(703) 761-2377____
Telephone number

October 2, 2008
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Samuel S. Adams, et al.

Serial No.:	10/785,227	**Group Art Unit**:	2143
Filed:	February 25, 2004	**Examiner**:	Belani, K.

For: METHOD AND STRUCTURE FOR AUTOMATED LAYOUT DIRECTOR

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' ARGUMENTS FOR PRE-APPEAL BRIEF CONFERENCE

Prior to developing and filing a formal Appeal Brief, Appellants submit the following arguments for review by the Pre-Appeal Brief Conference.

1.   THE 35 USC §101 REJECTION

Claim 15 stands rejected under 35 U.S.C. §101 as allegedly directed toward non-statutory subject matter. As Appellants explained in their initial response to this rejection, the description in the specification relates to <u>storage</u> of computer instructions, <u>not</u> the transmission of those instructions, and any reliance by the Examiner on this wording is clearly and improperly <u>taking one or two words out of the context</u> of the remainder of the sentence.

However, in an effort to expedite prosecution, Appellants were willing to amend claim 15 to incorporate the word "storage" to thereby preclude the Examiner's out-of-context interpretation. In the Advisory Action mailed on September 8, 2008, the Examiner alleged such change would raise a new issue. Appellants believe that a 101 rejection cannot be based upon taking wording out of context and that no new issue was raised by this wording clarification.

2.   THE PRIOR ART REJECTIONS

The Examiner alleges that Kamata teaches the claimed invention described by claim 14 and, when further modified by Digate, renders obvious claims 12 and 13. The Examiner

also alleges that Van Dok, when modified by Digate, renders obvious claims 1, 2, and 15, and, when further modified by Kamata, renders obvious claims 3-7, 9, and 10, and, when further modified by Moran, renders obvious claims 8 and 11.

Appellants submit, however, that there are elements of the claimed invention which are neither taught nor suggested by Kamata or Van Dok, even if modified by the prior art currently of record.

The Rejections Based on Kamata

More particularly, relative to the rejections based on Kamata, although this reference provides a capability for each terminal to control its display contents, there is no suggestion in Kamata to use the method of the present invention of having "user-specified rules", as that term is described in the present application at, for example, line 18 of page 13 through line 10 of page 15.

Thus, as explained at lines 21-22 of page 13, each layout rule might be of the form "*(Condition) (Layout Specification)*", so that the user's layout rules comprise a Boolean combination of conditions, as described in dependent claim 2 (newly-incorporated into independent claim 14, in an attempt to expedite prosecution). There is no suggestion that the user's selection in Kamata uses such a format.

The most that would seem reasonably descriptive in Kamata relative to the user's directions for contents of the received composite signal would seem to be the description at line 64 of column 9 through line 4 of column 10:

"*In FIG. 7, by each select memory 46 storing select data as to which input the corresponding selector 47 is to select pixel by pixel, each of the n image combining units 35 is allowed to produce a different composite image and send it to the corresponding terminal. Thus, each individual participant in the conference can specify only the participants he or she wants to see, and optionally specify the arrangement of their images in the composite image.*"

Therefore, although the mechanism in Kamata, as described above, may permit each user to make customized selections, this mechanism is clearly not using the layout rules described in the present application. Rather, the selection in Kamata is merely a controlling which of the *n* images are forwarded to each user terminal. This is a different concept from that of using "layout rules", as defined in the present application.

In an attempt to expedite prosecution, Appellants were willing to have added the description of dependent claim 2 incorporated into independent claim 14, to clarify how

"layout rules" of the present invention is distinguished from the switch selection mechanism described in Kamata. The Examiner refused entry of this amendment, considering such clarification by adding content of an original dependent claim would raise a new issue. Appellants disagree that a new issue was raised.

Moreover, relative to the rejection for claims 12 and 13, Appellants again point out that secondary reference Digate has nothing to do with layout rules. That is, the rules from Digate et al. describe how information is to be delivered (e.g., IM), not how it is to be displayed (e.g., laid out in the display). There is no description whatsoever regarding layout, thus, it would not be obvious to generalize Kamata to cover layout, based on secondary reference Digate.

Therefore, even if secondary reference Digate were to be incorporated into primary reference Kamata, the combination would not provide all the elements of these claims.

Therefore, there are clearly elements of the claimed invention that are not present in Kamata, and Appellants respectfully submit that claims 12-14 are clearly patentable over Kamata.

The Rejections Based on Van Dok

Relative to the rejection for claims 1, 2, and 15, Appellants submit that this reference is not reasonably related to the claimed invention. As Appellants explained, the term "composite" is defined differently in Van Dok from the meaning in the present application. Van Dok allows a user to reformat the text (and graphic images like the icon ":-)") presented in an interleaved composite image. No facility is given for specifying how to display feeds in separate subpanes. That is, all of one user's input in a 2" x 2" window, located in the top left hand corner of the overall composite image; with all of the second user's input displayed in smaller window, located in the bottom right.

Further, the rules from Digate et al. describe how information is to be delivered (e.g., IM), not how it is to be displayed. There is no description whatsoever regarding layout, thus, it would not be obvious to generalize Van Dok to cover layout, based on secondary reference Digate.

In the Examiner's response on page 25, the Examiner states: *"How the specification defines "composite" does not make these claims allowable."*

In response, Appellants respectfully submits that the claim language itself distinguishes from the technique of primary reference van Dok. That is, as clearly described

in even the abstract, van Dok is related to a real-time communication such as instant messaging. It does <u>not</u> relate to a video meeting environment such as described in the present application.

This difference shows up in the claim language of the independent claims. For example, in van Dok there is nothing corresponding to "… <u>layout</u> rule for a customized composite <u>image</u> of said online meeting", as required by independent claim 1. There is no image of the online meeting being presented in van Dok, since only users' <u>text messages</u> are displayed in this reference. Even if the display of the text messages of van Dok were to be considered as a composite image of the session, there are no <u>layout</u> rules in van Dok. The examples given by the Examiner concern font selections and content of the messages, which would not qualify as "layout rules", even in a broad interpretation of this term.

Therefore, even if secondary reference Digate were to be incorporated into primary reference Van Dok, the combination would not provide all the elements of these claims.

Moreover, relative to the rejection for claim 2, the conditions shown in Figure 9 of Digate are not "layout rules", as described in the specification, for example, at lines 7-8 of page 9, referring to layout rules in the subsequent discussion for Figures 8 through 11.

Relative to the rejection for claims 3-7, 9, and 10, Van Dok et al. do not provide a way to control subpane layout, only interleaved content formatting. Further (re: page 10) Kamata et al. allow a user to "select", but nowhere are any sort of "layout based rules" described, either in the abstract, or column 2, ,lines 31-41; only selection from a predefined of size and location choices. Thus it would not have been obvious.to generalize Kamata et al. to cover a method which does include the specification of layout rules.

Relative to the rejection for claim 4, Van Dok et al. Fig 6a 604 is an input field, not a display window showing a feed from one ore more remote users; AND the size of this pane is not controlled by a rule, since the rules of Van Dok et al. concern delivery, not display layout.

Relative to the rejection for claim 7, the information shown in Figure 4 of Kamata makes no suggestion of a calculation of layout rules.

Relative to the rejection for claim 8, the information shown in Figure 4 of Digate makes no suggestion of a periodic checking of layout rules.

Relative to the rejection for claim 9, the cited text from Van Dok et al. does not cover the case where the number of text or video feeds is a used as a parameter.

Relative to the rejections for claim 11, as explained above for claim 1, the term

"composite" is defined differently in Van Dok from the meaning in the present application. Van Dok allows a user to reformat the text(and graphic images like :-)) presented in an interleaved composite image. No facility is given for specifying how to display feeds in separate subpanes, and secondary reference Digate describes, at most, how information is to be delivered (e.g., IM), not how it is to be displayed. There is no description whatsoever regarding layout, so that Digate does not overcome this fundamental deficiency of primary reference Van Dok.

Therefore, Appellant submits that there are elements of the claimed invention that are not taught or suggested by Van Dok, and the Examiner is respectfully requested to withdraw these rejections.

Respectfully Submitted,

Date: October 2, 2008

_____
Frederick E. Cooperrider
Registration No. 36,769

McGinn Intellectual Property Law Group, PLLC
8321 Old Courthouse Road, Suite 200
Vienna, VA 22182-3817
(703) 761-4100
Customer No. 21254

CERTIFICATION OF TRANSMISSION

I certify that I transmitted via EFS the above for the Pre-Appeal Brief Conference to the USPTO on October 2, 2008.

Frederick E. Cooperrider
Reg. No. 36,769